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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/825,258	04/03/2001	Sita R. Kaura	146323.00001	2051

7590 10/16/2002

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[REDACTED] EXAMINER

HUI, SAN MING R

ART UNIT	PAPER NUMBER
1617	

DATE MAILED: 10/16/2002

REC'D 10-18-02 PGF&M

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/825,258	KAURA, SITA R.
	<b>Examiner</b>	<b>Art Unit</b>
	San-ming Hui	1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 08 July 2002.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.
- 4) Claim(s) 14-18,23-30 and 32-48 is/are pending in the application.
- 4a) Of the above claim(s) 16-18,30 and 32-48 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 14,15 and 23-29 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.  
4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.  
5) Notice of Informal Patent Application (PTO-152)  
6) Other: \_\_\_\_\_

### DETAILED ACTION

The amendments filed July 8, 2002 have been entered. The cancellation of claim 31 is acknowledged.

The outstanding objections of claims 23, 24, 29, and 31 have been withdrawn in view of the amendments of the claims filed July 8, 2002.

The outstanding rejections under 35 USC 103 are withdrawn in view of the amendments filed July 8, 2002. The deletion of one of the antihistamine: loratadine overcomes the outstanding obviousness rejection set forth in the previous office action mailed January 3, 2002.

As the elected specie, loratadine, is deleted from the claims, the search has extended, in this instance, to cetirizine as the antihistamine specie.

The claims have been examined herein to the extent they read on the elected invention and species.

Claims 14-18, 23-30 and 32-48 are pending.

Claims 16-18 and 36-48 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 4, received December 10, 2001.

Claims 30, and 32-35 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 4 received December 10, 2001.

***Claim Objections***

Claims 26 and 28 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Both claims 26 and 28 recite loratadine as antihistamine, which is not recited in the independent claims.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14-15, and 23-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dahlen et al. (WO 97/28797) in view of Katzung ("Basic & Clinical Pharmacology", 6th ed., 1995, page 312-314), both references of record, and Spector et al. (J. Allergy Clin. Immunol., 1995; 96(2):174-181).

Dahlen et al. teaches an asthma treating composition comprises Loratadine and Montelukast sodium (See particularly page 5, Example, whole page).

Dahlen does not expressly teach the asthma treating composition contains a adrenergic bronchodilator such as albuterol. Dahlen does not expressly teach the asthma composition containing cetirizine.

Katzung teaches that albuterol is useful in treating asthma (See particularly page 314, col. 1, first paragraph).

Spector et al. teaches cetirizine is effective in treating mild-to-moderate asthma due to its significant bronchodilatory effect (See particularly the abstract).

It would have been obvious to one skill in the art when the invention was made to incorporate albuterol into the asthma treating composition of Dahlen et al. It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute cetirizine for loratadine in composition of Dahlen et al.

One of ordinary skill in the art would have motivated to incorporate albuterol into the asthma treating composition of Dahlen et al. because combining agents which are known to be useful to treat asthma individually into a single composition useful for the very same purpose is *prima facie* obvious. See *In re Kerkhoven* 205 USPQ 1069. One of ordinary skill in the art would have been motivated to substitute cetirizine for loratadine in composition of Dahlen et al. because both cetirizine and loratadine are both antihistamine agent and both are known to be useful in asthma treating composition. Therefore, substituting any known asthma treating antihistamine compounds, including cetirizine, for loratadine would have been reasonably expected to be useful in formulating a composition useful for treating asthma.

It is applicant's burden to demonstrate unexpected results over the prior art. See MPEP 716.02, also 716.02 (a) - (g). Furthermore, the unexpected results should be demonstrated with evidence that the differences in results are in fact unexpected and unobvious and of both statistical and practical significance. *Ex parte Gelles*, 22 USPQ2d

1318, 1319 (Bd. Pat. App. & Inter. 1992). Moreover, evidence as to any unexpected benefits must be "clear and convincing" *In re Lohr*, 137 USPQ 548 (CCPA 1963), and be of a scope reasonably commensurate with the scope of the subject matter claimed, *In re Linder*, 173 USPQ 356 (CCPA 1972).

### ***Response to Arguments***

Applicant's arguments with respect to claims 14, 15, and 23-29 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Application/Control Number: 09/825,258  
Art Unit: 1617

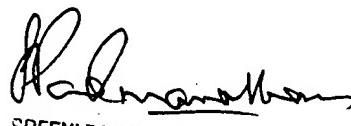
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to San-ming Hui whose telephone number is (703) 305-1002. The examiner can normally be reached on Mon 9:00 to 1:00, Tu - Fri from 9:00 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, PhD., can be reached on (703) 305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

San-ming Hui  
October 3, 2002

  
SREENI PADMANABHAN  
PRIMARY EXAMINER 